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Ostrolenk, Faber, Gerb & Soffen, LLP
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New York, New York 10036

In re Application of :
CARLISLE, Geoffrey :
Application No.: 10/577,802 :
PCT No.: PCT/AU04/01502 :
Int. Filing Date: 29 October 2004 :
Priority Date: 30 October 2003 :
Attorney Docket No.: P/4954-9 :
For: BUILDING FORMWORK MODULE FOR
USE IN A MODULAR CONCRETE
FORMWORK SYSTEM

DECISION ON REQUEST

This decision is issued in response to the "Petition to Correct Inventorship under 37 CFR 1.497(d)" filed 30 April 2007. The \$130 petition fee has been submitted.

BACKGROUND

On 29 October 2004, applicant filed international application PCT/AU04/01502 which claimed a priority date of 30 October 2003. The published international application identified two applicant/inventors for the United States: Geoffrey Carlisle and Bruce Howard Goldby. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 30 April 2006.

On 28 April 2006, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; a copy of the international application; and a preliminary amendment.

On 08 November 2006, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 30 April 2007, applicant filed the present request under 37 CFR 1.497(d) to remove inventor Bruce Howard Goldby as an inventor.

DISCUSSION

The present submission seeks to correct the inventorship so as to remove inventor Bruce Howard Goldby from the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

- (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:
 - (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
 - (2) The processing fee set forth in § 1.17; and
 - (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
 - (4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to the removal of Bruce Howard Goldby from the application, applicant's 30 April 2007 submission satisfies requirements (1), (2), and (4).

Item (3) has not been satisfied. Applicant has not provided the assignee's consent to the removal of Bruce Howard Goldby as an inventor herein. Applicant must provide such consent before item (3) can be considered satisfied. Such consent must be accompanied by a statement under 37 CFR 3.73(b) which includes either a copy of the assignment documents or a specific reference to the assignment's recorded location in the USPTO (i.e., reel and frame number) (see 37 CFR 3.73(b)).

Because applicant has not satisfied all the requirements of 37 CFR 1.497(d), inventor Bruce Howard Goldby cannot be removed from the application on the present record.

CONCLUSION

Applicant's request to remove inventor Bruce Howard Goldby under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

Applicant must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b). Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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